

REMARKS

Applicants thank the Examiner for the thorough consideration given the present application.

To expedite prosecution, independent method claim 1 and independent system claim 21, as well as dependent claims 2, 4, 16, 23, and 31, have been amended. The amendments to claim 1 assume that it will not be construed as being under 35 U.S.C. §112, sixth paragraph. Claims 16 and 31 have also been amended to assure open-ended coverage. Claims 3, 5-15, 17-20, 22, and 24-30 have been cancelled.

As originally submitted, independent claims 1 and 21 were not anticipated by Hall et al., U.S. 6,026,375, as alleged in the Office Action. However, these independent claims have been amended to further distinguish over Hall et al.

Hall et al. discloses a "method and apparatus for processing orders from customers in a mobile environment". A user wishing to order goods or services sends an order to a service system, which first looks up user preferences in a customer database 374 (FIG. 3) and then uses the user's location, together with any preferences found in the customer database, to determine suitable facilities for satisfying the user's order by a location-dependent look up in a facilities database 372.

At column 9, lines 27-31, Hall et al. states:

Preferably, the local facility is the facility nearest geographically to the customer's location at the time of the order or a facility that is convenient to the customer's planned travel route, such as on the way home from work.

The Office Action implies that Hall et al. inherently includes many of the claimed features. However, the Examiner has the burden of proof with regard to inherency. The fact that a certain result or characteristic **may** occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.

In re Rijckaert, 9 F.3d 1531, 1534, 28 U.S.P.Q. 1955, 1957 (Fed. Cir. 1993); *In Re Oelrich*, 666 F.2d 578, 58, 582, 212 U.S.P.Q. 323, 326 (CCPA 1981). To establish inherency, extrinsic evidence must make clear that the missing descriptive matter is **necessarily** present in the thing described in the reference and that it would be so recognized by persons of ordinary skill in the art. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Roberston*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-1951 (Fed. Cir. 1999). In relying upon a theory of inherency, the Examiner must provide a basis in fact or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art. *Ex parte Levy*, U.S.P.Q.2d 1461, 1464 (BPAI 1990).

Further, amended claims 1 and 21 include limitations the Hall et al. reference does not disclose. Claims 1 and 21 now require carrying out two location-dependent searches. The first search determines the enquirer-independent functional significance of the enquirer's

location. This significance is used to set the geographical coverage for the second search.

Hall et al. does not disclose carrying out an explicit search for the enquirer-independent functional significance of the enquirer's location. Hall also fails to disclose a second location-dependent search in which the enquirer-independent functional significance sets the geographical limits of the search. While Hall et al. has a service system for checking that a particular local facility (that is, one already identified as local) can satisfy the order concerned, this checking is done on the basis of the identity of the local facility concerned. The service system checking is not a location-dependent search because the local nature of the concerned facility has already been ascertained. These subsidiary checks are described at column 9, lines 34-51.

At the bottom of page 2, the Office Action states that if the "local facility" is determined to be one that is convenient to the customer's planned route, "the system is attributing a significance to the enquiry location through a database lookup (i.e., the facilities database". However, there are at least three defects with the foregoing reasoning *vis-à-vis* presently amended claim 1:

1. The Hall et al. reference has no disclosure of how a lookup in the facilities database tells the system the customer's current location is on the customer's planned route.

2. If this database lookup is the database lookup of the facility, there is no second location-dependent database lookup as required by amended claims 1 and 21.

3. The significance attributed to the customer's location (customer's planned route) is not "an enquirer-independent functional significance" as recited in amended independent claims 1 and 21.

Concerning issue 3, there is no disclosure in Hall et al. of determining which facilities are closest to the customer's planned route. Hall et al. does not disclose how this might be achieved (as opposed to a projected track based on current speed and direction). If a person skilled in the art were to consider the issue, there appear to be two questions needing to be resolved:

First, how does the service system know the customer's planned route?

Clearly, the user must have somehow communicated his intended route to the system. One way to do this is for the user to input the planned route into a vehicle auto-navigation system that communicates the information to the service system. Alternatively, the user could have directly informed the service system. This could have been done by storing route information in customer database 374.

Second, how does the service system know the customer's planned route?

One possibility is that the service system does not, in fact, know how to look for facilities close to the customer's planned route,

but simply looks automatically. Alternatively, the customer may specifically request that the service system uses the planned route as the basis for the facilities lookup. A further possibility is to use time of day to indicate the basis for the facilities lookup. A further possibility is to use time of day to indicate when the service system should use the planned route. The service system could possibly compare the customer's current location with a planned route stored in the customer database.

It can, therefore, be seen that the solution corresponding to that defined by amended claims 1 and 21 requires a combination of choices as to how a person of ordinary skill in the art would cause the service system to search the facilities database for facilities close to the customer's planned route. Clearly, Hall et al. does not anticipate even original claims 1 and 21, since a variety of possibilities exist that do not correspond to original claims 1 and 21.

Furthermore, it would not have been obvious to choose the particular solution defined by claims 1 and 21.

As already noted, looking up a "local facility" based on closeness to a planned route does not involve attributing a customer-independent functional significance to the customer's location. If the customer's location is on a planned route, this is entirely dependent on the customer's having planned that route. In this respect, in commenting on original claim 3, the Office Action on page 3 states that the customer's travel route is indicative of a functional purpose of

the customer's location. However, a customer's planned route merely indicates that the customer is planning to travel along the route and does not imply anything about a customer's current location. For example, the customer's current location does not imply that the customer is on a road because there is no indication that the customer is in the vehicle or that the vehicle is on a road, as opposed to in a garage or even in an off-road environment.

Attorney for Applicants wishes to advise the Examiner that the drawings and description thereof in this application are the same as in copending Application Serial No. 09/829,436, filed concurrently with the present application.

In view of the foregoing amendments and remarks, allowance is in order.

The Commissioner is authorized to charge any omitted fees, including extension of time and extra claims fees, to Deposit Account 07-1337.

Respectfully submitted,

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